

Application No.: 10/812,449  
Amdt. Dated January 6, 2006  
Reply to Final Office Action of November 7, 2005

Docket No.: G00342/US

### REMARKS

Applicants have carefully reviewed the Final Office Action mailed November 7, 2005. Claims 3 and 23 have been amended to correct a typographical error. Accordingly, claims 1-25 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the following remarks.

#### Claim Rejections – 35 U.S.C. § 102

Claims 1-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,585,601, *Booker et al.* For at least the following reasons, Applicant respectfully traverses the rejection.

Applicants note that in rejecting each claim, the Examiner duplicates the Non-Final Office Action of June 20, 2005 with no meaningful correlation of the prior art reference and the limitations of the pending claims. In the response to the Non-Final Office Action of September 7, 2005, Applicants discussed a portion of the inadequacies of *Booker* to establish a *prima facie* case of anticipation. In this response, Applicants will discuss further the limitations of the pending claims that are *clearly* not shown in Figure 1 of *Booker*.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Drawings may be used as an anticipatory reference, but only for those things *clearly* shown. See *In re Mraz*, 173 USPQ 25 (CCPA, 1972), *emphasis added*. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech Inc.* 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

#### **Independent Claim 1**

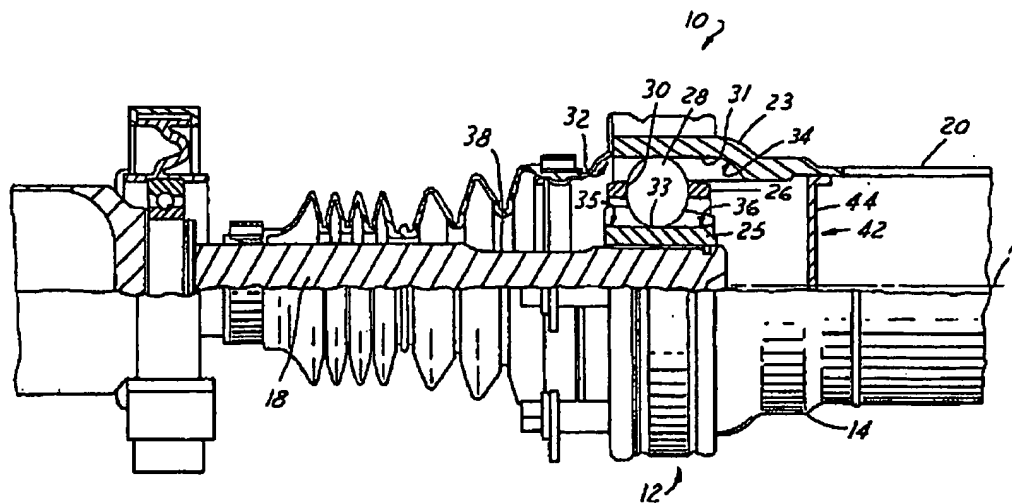
Independent claim 1 positively recites "a plurality of plunging convolutes," and "a second stabilizing member joining the plurality of plunging convolutes and the grease catching member, the second stabilizing member adapted to ride above an outer race of the ball spline

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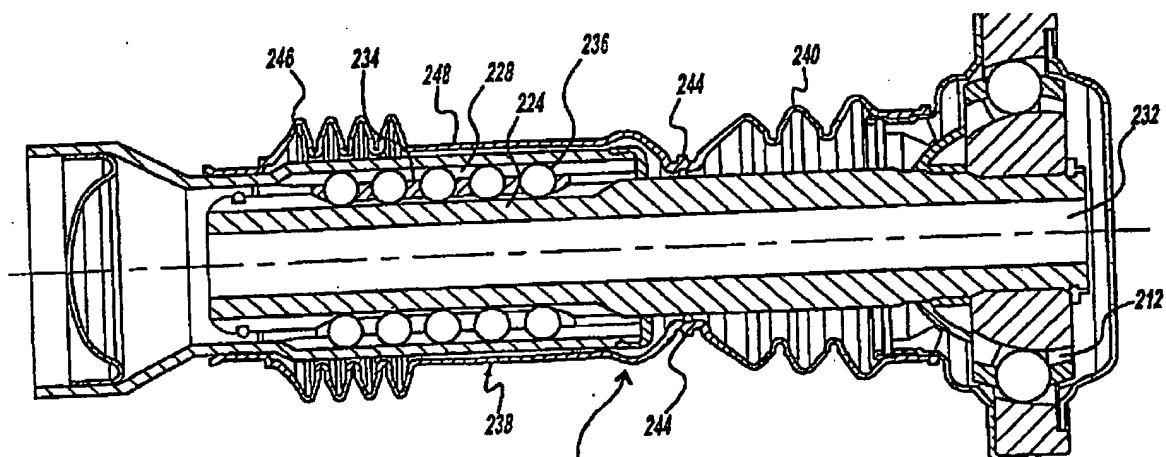
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joint.” In contrast, Booker does not teach a second stabilizing member, or any other part of a boot, that can ride above an outer race of any joint. Thus, Booker does not teach every limitation of independent claim 1, as required in *Verdegaal Bros.*

Below is Figure 1 of Booker and FIG. 4 of the present application.



**Figure 1 of Booker**



**Figure 4 of the present Application**

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### **Independent Claim 12**

Independent claim 12 positively recites a "constant velocity joint" and a "ball spline joint having an inner race and an outer race." In contrast, while Booker teaches a constant velocity joint, no ball spline joint is shown or disclosed. Thus, Booker does not teach every limitation of independent claim 12, as required in *Verdegaal Bros.*

Furthermore, independent claim 12 also recites a boot comprising a "first stabilizing member adapted to ride above the inner race of the ball joint." In contrast, Booker discloses a solid shaft 18 within the boot, and does not teach any portion of a boot that rides above any portion of an inner race of any joint.

### **Independent Claim 23**

Independent claim 23 positively recites, at least in part, a "second stabilizing member joining and contiguous with the plurality of plunging convolutes and the grease catching member, the second stabilizing member having a substantially constant wall thickness and adapted to ride approximately 1 mm above an outer race of the ball spline joint to provide additional stability." In contrast, Booker does not disclose a portion of a boot that rides above an outer race of a ball spline joint. Accordingly, Booker does not teach every limitation of independent claim 23, as required in *Scripps Clinic & Research Foundation*.

### **Dependent Claims**

Dependent claims 2-11, 13-22, and 24-25 contain additional limitations not shown or disclosed in Booker. Further, the dependent claims are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

### **Comments on Examiner's Response to Arguments**

In the response dated September 6, 2005, the Examiner was requested to point out what portions of Figure 1 of Booker correlate to the limitations of the pending claims.

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(Response to Non-final Office Action, page 6). The Examiner asserted in the Final Office Action of November 7, 2005 that there is no requirement "to provide reference numbers for an invention that is clearly anticipated." (Final Office Action, page 6). While the Examiner may not be required to point out by reference numbers what elements are alleged to be shown in the drawings, the Examiner is required to adequately identify what limitations are alleged to be shown in the prior art. Since the Examiner has simply repeated Applicants' claim limitations, with no correlation to specific portions within the prior art (with the exception of the identification of an alleged grease catching member in FIG. 1 of the prior art in page 7 of the Final Office Action dated November 7, 2005), it is unclear to Applicants what the Examiner considers to be, for example, a first stabilizing member, a second stabilizing member, a constant velocity joint, or a ball spline joint.

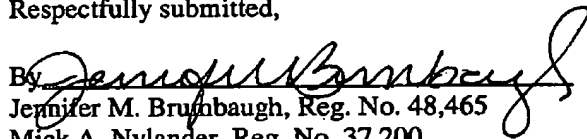
#### Conclusion

In view of the above remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 07-1360, under Order No. G00342/US from which the undersigned is authorized to draw.

Respectfully submitted,

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